

REMARKS

I. Record of Interview and Request for Telephone Interview

The undersigned attorney spoke with Examiner Mai on February 23, 2005 and requested a telephone interview to discuss the claims presented herein. Examiner Mai instructed the undersigned attorney to include a paragraph in this Amendment requesting a telephone interview and assured the undersigned attorney that an Examiner would contact him once the application is assigned to an Examiner (but before examination). The undersigned attorney looks forward to the telephone call from the Examiner assigned to this application. The undersigned attorney's telephone number is (312) 321-4719.

II. Claims 23-27

Claims 23-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,852,896 to Mills. For at least the reasons set forth in Applicants' previous response, Applicants respectfully submit that one skilled in the art would not have been motivated to modify Mills as proposed in the Office Action. However, to expedite the prosecution of this application, Applicants have amended independent Claim 23 to recite elements that are clearly not shown or suggested by Mills.¹

Claim 23 now recites that the billiard ball holder has a lower end that is received in a second rack portion. This element is not shown in Mills. As shown in Figures 2 and 3 in Mills, the side of the ball holder 156 is secured to a tubular member 124 with a screw 162, and the lower end of the ball holder is not in contact with any part of the golf bag (the L-shaped bracket 160 shown in Figure 3 only contacts the interior side — not the lower end — of

¹ Applicants have amended other elements of Claim 23 and several dependent claims to clarify those claims.

the ball holder 156). Accordingly, the golf bag does not contain a rack portion that receives the lower end of the ball holder 156. Thus, even if Mills were modified as proposed in the Office Action to carry billiard balls and cues, the proposed combination would not yield the invention recited in Claim 23 because the structural relationship recited in Claim 23 between the ball holder and the rack portion is not shown in Mills.

Applicants also respectfully submit that one skilled in the art would not have been motivated to further modify Mills to yield the claimed invention. The ball holder 156 is already secured to the golf bag with a screw 162. Applicants respectfully submit that one skilled in the art would not have been motivated to add a component that only serves to increase cost and complexity without providing any additional benefit. Applicants note that the L-shaped bracket 160 retains balls in the ball holder 156. Accordingly, a component that receives the lower end of the ball holder 156 would not provide a ball-retaining function. Further, Applicants submit that one skilled in the art would not have been motivated to replace the L-shaped bracket 160 with a component that receives the lower end of the ball holder 156 to retain balls as this would replace a simple and cost-effective design with one that requires additional complexity and cost.

In summary, because Mills does not teach or suggest a billiard ball holder having a lower end received in a second rack portion of a billiard balls and cues rack, Applicants respectfully request that the rejections of independent Claim 23 and its dependent claims be withdrawn.

III. New Claims 28-35

Applicants have added new Claims 28-35, which recite elements that are not shown or suggested by Mills or the other art of record. New independent Claim 28 recites a rack for storing billiard balls and cues that has a portion that comprises two sets of openings: a plurality of first openings configured to receive upper ends of a plurality of billiard cues and a second

opening configured to receive the upper end of a billiard ball holder. In contrast, the golf bag in Mills does not contain a component having openings both for golf clubs and for a golf ball holder. In Mills, the golf bag has a circular member 116 that contains clips 114 to receive golf clubs but does not contain any mechanism to receive the golf ball holder 156. Instead, the golf ball holder 156 is secured to a separate component: the tubular member 124. Also, one skilled in the art would not have been motivated to add an opening in the circular member 116 for the golf ball holder 156 because such an addition would increase the diameter of the circular member 116 and thereby make the golf bag larger and more cumbersome.

Dependent Claims 29-35 are patentable over Mills by virtue of their dependence on independent Claim 28. Further, the additional elements recited in these claims provide additional grounds of patentability. For example, dependent Claim 30 recites that the plurality of openings that receive the upper ends of billiard cues are arranged in a line. As shown in Figure 6 in Mills, the clips 114 in the circular member 116 that hold golf clubs are arranged in a circle. Arranging these clips 114 in a line would result in a rectangular-shaped golf bag that would be unwieldy and difficult to move. As another example, dependent Claim 31 recites that the billiard ball holder comprises an opening sized to receive a billiard ball with a diameter of at least about 2.25 inches. Since this diameter is larger than the size of a typical golf ball, dependent Claim 31 provides another distinction over Mills. Further dependent Claim 32 recites that the length of the billiard ball holder that is more than one half the length of a billiard cue stored in the rack. As shown in Figure 1 of Mills, the length of the golf ball holder 156 is less than one half the length of a golf club.

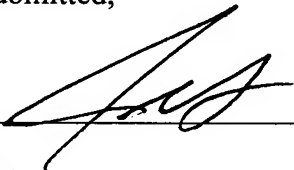
IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance. Reconsideration is respectfully requested.

Applicants look forward to the Examiner's call before examination.

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Respectfully submitted,



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